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TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John Joseph Mascavage, III et al.

Application No.: 10/076,036

Filed: February 13, 2002

For: BUTTONS FOR PERSON TO
PERSON PAYMENTS

Confirmation No. 7402

Examiner: Maguire, Lindsey M.

Technology Center/Art Unit: 3692

APPELLANTS' BRIEF UNDER
37 CFR §41.37

Mail Stop **Appeal Brief**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on June 11, 2007 for the above-referenced application, Appellants submit this Brief on Appeal.

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1. REAL PARTY IN INTEREST

The entire right in the above-referenced patent application has been assigned to First Data Corporation of Greenwood Village, Colorado and The Western Union Company of Englewood, Colorado, who are the real parties in interest.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-22 and 24-27 are pending. Claims 1-22 and 24-27 have been finally rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,699,528 issued to Hogan. All pending claims are appealed.

4. STATUS OF AMENDMENTS

A response to the Office Action dated October 31, 2006 was filed on January 31, 2007. This amendment was entered by the Examiner. No amendment has been filed in response to the Final Office Action mailed March 9, 2007. A copy of the pending claims, after entry of the Amendment filed on January 31, 2007 is provided in the appendix, attached hereto.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to online money transfers between buyers **110** and sellers **130** that use vending sites **140**. "Types of vending sites include auction sites, classified advertising sites, and other on-line sites that facilitate person-to-person sales." Application, p. 2, lines 31-32. A buyer **110** relies on a payment enabler **170** to allow the money transfer in the person-to-person sale. Id., p. 2, line 32-p. 3, line 2; see also p. 3, lines 23-33. To enable the payment process with the payment enabler **170**, a snippet, which may have a link and a button associated therewith, is pasted into the vendor site **140**. Id., Fig. 5, step 532; see also p. 9, lines 15-19 and p. 9, line 30-p. 10, line 8. The button associated with the snippet changes when the

buyer 110 can make a payment. See *id.*, p. 13, lines 1-9. The buyer 110 can then select the button, and the link associated with the button, to be directed to the payment enabler 170. *Id.*, Fig. 6, step 624, see also p. 13, lines 31-32. The payment enabler 170 then helps transfer money from the buyer 110 to the seller 130 associated with the sale on the vendor site 140. *Id.*, Fig. 6, step 644.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Issue I: Whether under 35 U.S.C. §102(b) claims 1-22 and 24-27 are anticipated by U.S. Patent No. 5,699,528 issued to Hogan ("Hogan"). Pages 2 through 4 of the Office Action, mailed March 9, 2007, describe the Examiner's current position on this issue.

Issue II: Whether under 37 CFR 1.98(a)(3) the Appellants are required to submit a concise explanation of relevance for English language references listed in an Information Disclosure Statement. Page 2 of the Office Action, mailed March 9, 2007, describes the Examiner's current position on this issue.

7. ARGUMENT

I. Issue I:

The Office Action has rejected claims 1-22 and 24-27 as anticipated by Hogan. The patent office is charged with putting forth a *prima facie* showing of anticipation. Appellant believes a *prima facie* case of anticipation has not been properly set forth in the Office Action. The basic test is excerpted below:

"[For] anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." See *MPEP* §706.02, Original Eighth Edition, August, 2001, Latest Revision August 2006.

Appellant believes the rejection has flaws with the above test for anticipation. Notably, the Hogan reference fails to teach each and every aspect of the claimed invention.

Teachings Missing from the Cited References

With regard to the anticipation rejection, Appellant believes that Hogan does not teach or suggest the invention in the claims. More specifically, Hogan fails to teach or suggest

"a vending site," and, as such, fails to teach or suggest the following elements of independent claim 1: "receiving login information relevant to a vending site," "automatically determining listings at the vending site associated with the seller," or "automatically inserting one of the plurality of snippets into each of the listings." For at least these reasons, Appellant respectfully requests for reconsideration of the rejection to the claims.

Missing Limitation: Receiving Login Information Relevant to a Vending Site

Claim 1 requires "receiving login information relevant to a vending site."

Vending sites include on-line sites that facilitate person-to-person sales, such as online auction sites. Application, p. 2, lines 31-32. Hogan is cited for this proposition on page 3 of the Office Action by simply listing reference (305) as including information about the vending site. Office Action, page 2, fourth sentence. Step (305) is an action by a "subscriber" to enter his or her identification into a server computer. See Hogan, col. 5, line 63 -- col. 6, line 1. A "subscriber," in Hogan, subscribes to a bill payment server. See id., col. 4, lines 22-25. The subscribers "are able to access and 'browse' their bills on WWW, and pay the bills using one or more accounts . . ." id., col. 5, lines 1-6. A subscriber is not a vending site because the subscriber does not facilitate person-to-person sales. Indeed, Hogan describes three entities: a subscriber, a payee (100), an electronic bill pay service (160) and a payee (107). See Hogan, Fig. 1 and col. 4, lines 22-67. Hogan does not teach, as shown in Fig. 1 of the Application, all of a buyer (110), a seller (130), a vending site (140), and a money transfer system (190). Hogan is missing any description of a vending site. Thus, the login information described in Hogan cannot be related to a vending site. Hogan does not teach this limitation.

Missing Limitation: Automatically Determining Listings at the Vending Site Associated with the Seller

Claim 1 also requires "automatically determining listings at the vending site associated with the seller." Listing could be classified advertisements, electronic advertisements or auctions. See Application, p. 3, lines 17-18. Hogan is cited for this proposition on page 3 of the Office Action by simply listing references (314) and (385) as determining listings at the vending site. Office Action, page 2, fourth and fifth sentences. Step (314) is an action to monitor an "Update Electronic Account Register" choice or a "Select New Payees" choice when

selected. See Hogan, col. 7, lines 37-62. Step (385) retrieves "available checking and credit account balances from the identified subscriber bank(s) . . ." Hogan, col. 7, lines 28-30. These steps fail to describe determining listings, for example, auctions, at a vending site, for example, an online auction site. Hogan does not teach this limitation.

Missing Limitation: Automatically Inserting One of the Plurality of Snippets Into Each of the Listings

Claim 1 also requires "automatically inserting one of the plurality of snippets into each of the listings." Hogan is cited for this proposition on page 5 of the Office Action by simply listing Figure 4 as inserting snippets into each of the listings. Office Action, page 5, first and second sentences. Figure 4 "is a display of a bill to be paid by a user . . ." Hogan, col. 3, lines 15-16. Figure 4 does not display a vending site or listings, but displays bills. As such, Hogan does not teach automatically inserting snippets into listings because the listings are on the vending site. Hogan does not teach this limitation.

II. Issue II:

The Office Action states the Appellants are required to submit a concise explanation of relevance for English language references listed in an Information Disclosure Statement. Appellant believes no explanation is required. According to 37 CFR 1.98(a)(3):

"A concise explanation of the relevance, as it is presently understood by the individual designated in §1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is *not in the English language*. (emphasis added)"

All cited references were in English. As such, Appellant believes the failure to examine the references cited in the Information Disclosure Statement is improper.

8. CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the Office Action dated March 9, 2007. Please deduct the requisite fees, pursuant to 37 C.F.R. § 1.17(f) from Deposit Account 201430 and any additional fees associated with this Appeal Brief.

For these reasons, it is respectfully submitted that the rejection should be reversed.

If, for any reason, the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned attorney at (303) 571-4000.

Respectfully submitted,



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9. CLAIMS APPENDIX

10. EVIDENCE APPENDIX

11. RELATED PROCEEDINGS APPENDIX

1. (Previously Presented) A method for facilitating payment between a buyer and a seller with an online money transfer performed over a wide area network, the method comprising steps of:

receiving login information relevant to a vending site, wherein the login information is associated with the seller;

automatically determining listings at the vending site associated with the seller; generating a plurality of snippets of HTML code for the listings, wherein each snippet includes a link;

automatically inserting one of the plurality of snippets into each of the listings, wherein activating the link points a web browser to a payment enabler that can transfer money from the buyer to the seller;

determining the listing has changed; and changing a graphic indicated by the snippet, which is caused, at least in part, by the determining step.

2. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, wherein one of the plurality of snippets indicates a graphic associated with the snippet and information unique to the seller and a listing including the snippet.

3. (Previously Amended) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, wherein:

the determining step comprises a step of concluding the listing has matured, whereby the purchaser is fixed; and

the changing step comprises a step of modifying a button graphic displayed by the snippet to reflect the listing is available to the buyer.

4. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, further comprising steps of:

determining one of the plurality of listings has matured, whereby the buyer is fixed;

automatically determining an electronic address of the purchaser; and
automatically sending a message to the electronic address of the purchaser.

5. (Previously Amended) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 4, wherein the message includes at least one of a web page, an instant message, an e-mail message, a pager message, or a wireless phone message.

6. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 4, further comprising a step of automatically determining a purchase price from the vending site.

7. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 4, wherein the message includes a snippet that points to the payment enabler and includes information relating to a listing associated with that snippet.

8. (Previously Amended) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, further comprising a step of determining from the vending site at least one of: a purchase price, a shipping amount, a listing description, a reference identifier used by the vending site, or an e-mail address of the buyer.

9. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in

claim 1, further comprising a step of receiving selection of a button graphic for display by the snippet.

10. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, further comprising steps of:

receiving authorization from the buyer to debit a money handler associated with the buyer; and

adding a credit in a stored value account of the seller as a result of the receiving authorization step.

11. (Previously Amended) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, further comprising a step of receiving at least two of a shipper selection, shipping insurance cost information, an address for the seller, tax information, an item description, a reference number, a payment enabler category, a purchase price, a phone number for the seller, a close date for the listing, or a quantity of items in the listing.

12. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, further comprising a step of receiving from the seller a message that is embedded in the plurality of snippets for display as part of each listing.

13. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the wide area network as recited in claim 1, further comprising a step of receiving login information relevant to a plurality of vending sites, wherein the login information for each of the plurality of vending sites is associated with the seller.

14. (Previously Presented) A method for facilitating payment between a buyer and a seller with an online money transfer performed over a computer network, the method comprising steps of:

receiving login information relevant to a vending site, wherein the login information is associated with the seller;

determining a listing at the vending site associated with the seller;

generating a snippet of code for the listing, wherein:

the snippet includes a link that addresses a payment enabler, and

the snippet indicates an information unique to the seller and the

listing including the snippet;

determining the listing has matured, whereby the buyer is fixed;

determining an electronic address of the buyer; and

automatically sending a message to the electronic address of the buyer.

15. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 14, further comprising a step of automatically inserting the snippet into the listings.

16. (Previously Presented) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 14, wherein the snippet indicates a graphic associated with the snippet.

17. (Previously Amended) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 14, wherein the message includes at least one of a web page, an instant message, an e-mail message, a pager message, or a wireless phone message.

18. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in

claim 14, further comprising a step of automatically determining a purchase price from the vending site.

19. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 14, wherein the message includes the link that points to the payment enabler and includes information relating to the listing.

20. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 14, further comprising steps of:

receiving authorization from the buyer to debit a money handler associated with the buyer; and

adding a credit in a stored value account of the seller as a result of the receiving authorization step.

21. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 14, further comprising a step of receiving from the seller a unique message that is embedded in the plurality of snippets for display as part of each listing.

22. (Previously Presented) A method for facilitating payment between a buyer and a seller with an online money transfer performed over a computer network, the method comprising steps of:

receiving login information relevant to a vending site, wherein the login information is associated with the seller;

determining a listing at the vending site associated with the seller;

generating a snippet of code for the listing, wherein the snippet comprises: a link that points to a payment enabler, and a message formulated by the seller for display to the buyer;

inserting the snippet into the listing;

determining the listing has matured, whereby the buyer is fixed;
automatically determining an electronic address of the buyer; and
automatically sending a message to the electronic address of the buyer.

23. (Canceled)

24. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 23, further comprising a step of automatically determining a purchase price from the vending site.

25. (Previously Amended) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 22, further comprising a step of determining from the vending site at least one of: a purchase price, a shipping amount, a listing description, a reference identifier used by the vending site, or an e-mail address of the buyer.

26. (Original) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 22, further comprising steps of:

receiving authorization from the buyer to debit a money handler associated with the buyer; and

adding a credit in a stored value account of the buyer as a result of the receiving authorization step. .

27. (Previously Presented) The method for facilitating payment between the buyer and the seller with the online money transfer performed over the computer network as recited in claim 22, wherein the snippet further indicates an information unique to the seller and the listing including the snippet.